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10/815,618	04/02/2004	Paul Quentin Scott	HYC010US	9402

  

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BALMAIN, 2041		
AUSTRALIA		

  

EXAMINER	
CARTER, CANDICE D	

  

ART UNIT	PAPER NUMBER
3629	

  

NOTIFICATION DATE	DELIVERY MODE
10/20/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/815,618	<b>Applicant(s)</b> SCOTT ET AL.	
	<b>Examiner</b> CANDICE D. CARTER	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-17, 20-23, 26 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-17, 20-23, 26 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. The Following is a Final Office Action in response to communications received on August 9, 2010. Claims 1 and 15 have been amended. No additional claims have been cancelled. No claims have been added. Therefore, claims 1-8, 14-17, 20-23, 26, and 31 are pending and have been addressed below.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-6, 14-17, 20-23, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris, JR et al. (20040134690, hereafter Norris) in view of Braun et al. (20040064783, hereafter Braun) in view of Pradhan et al. (6,968,178, hereafter Pradhan) in view of Lieberman (5,855,369) and further in view of Nishida et al. (6,343,311).**

As per claim 1, Norris discloses a method of enabling submission of form data to an application via a printed form, whilst maintaining anonymity of a competition entrant, the printed form having coded data readable by a registered sensing device as the sensing device is used to interact with the form, the method including the steps, performed in a computer system, of:

receiving, from the sensing device: interaction data representing interaction of the sensing device with the coded data, the interaction data enabling the data to be

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electronically captured in the computer system; and a sensing device ID of the sensing device (§ 33 and 34 discloses receiving from a digital sensor pen stroke, biometric, and pattern position information, where biometric data includes a unique pen ID and § 43 and 44 discloses capturing information in a server);

allocating a temporary registration to the sensing device ID or to a user associated with the sensing device based on the telecommunication address of the relay device (§ 61 discloses a user registering the pen; § 35 and Fig. 1 disclose communication links for sending and receiving information back and forth from/to the pen, where there inherently is some telecommunications address in order for such communications to take place; and § 47 discloses authenticating the pen using its MAC [telecommunications] address where this authentication data is stored in a profile as disclosed in § 5 and where storing authentication and profile data is apart of the registration process as in § 61);

store the temporary registration in a registration database (§ 36 discloses storing profile data at a server that contains a database for storing profile data so that biodata may be compared against it, where profile data includes the registration information as disclosed in § 61)

the temporary registration is used to identify a return address for sending information to the user (§ 47 discloses authenticating the pen using its MAC [telecommunications] address where this authentication data is stored in a profile as disclosed in § 5 and where storing authentication and profile data is apart of the

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registration process; in addition in ¶ 49 Norris also discloses storing return address information at the server)

Norris, however, fails to disclose where the data is form data and transmitting the form data to the application; and identifying, using the sensing device ID, a registered a telecommunication address recorded for the competition entrant; a form data that is an entry to a competition; allocating, using a registered telecommunications address, a temporary alias registration to the sensing device ID or to the competition entrant associated with the sensing device ID; and a unique alias registration for every competition entry performed by a sensing device.

Braun discloses a method and system for remote form completion transmitting form data received by the system to an application (¶ 56 discloses receiving form data through the use of a digital pen and transmitting the form).

Pradhan discloses information acquisition by devices in wireless network identifying a telecommunications address of the relay device via which data was received (claim 20 discloses assessing messages received by the receiver for a reply telecommunications address).

In addition, Nishida discloses allocating an alias registration to a subscriber associated with a telecommunications address (See Fig. 10, col. 7, line 48-55, and col. 13, line 60-67).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system and method for processing mail of Norris to include the transmission of form data as taught by Braun since such

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would facilitate the communication and delivery of the data captured by the sensor, the identification of a telecommunications address of the relay device as taught by Pradhan in order to reply to received messages, and an alias registration allocated to a competition entrant associated with a telecommunications address as taught by Nishida since the known technique of associating an alias registration to a user would have predictably resulted in maintaining anonymity throughout the time that the alias is used. See KSR [127 S Ct. at 1739]

Lieberman discloses conducting a prize drawing game of chance where an entry form is scanned for entry into a competition (see col. 3, line 15-29).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include the competition entry as taught by Lieberman in order to facilitate the promotion of a particular product or item of merchandise.

Examiner takes Official Notice that having a unique alias registration for every competition entry for a competition is a concept that is old and well known in the art. For example, with reference to Philyaw (6,636,892), col. 28, line 6-39 discloses registration of a user is required before a user is allowed to participate in a contest, where registration involves a user providing a location, phone number, address, etc. while at the same time a serial number of a scanning device used to register the user is provided to establish a user code, where a user code is an alias for the user. Also, Higginson et al. (6,532,443) in col. 5, line 65-col. 6, line 3, and col. 6, line 47-52 discloses a contest participant having to register in order to participate in the contest

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and upon registering allocating a unique identifier to the participant. In addition, Howson (6,540,608) discloses in col. 4, line 14-41 all users registering a user name and password in order to participate in an internet lottery. Further still, Roseman (6,012,984) discloses in col. 2, line 47-53 discloses users registering to participate in a game.

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system of Norris to include an a unique alias registration for every competition entry performed by the sensing device in order to successfully identify a winning contestant or player (see Howson, abstract).

Claim 15 recites equivalent limitations to claim 1 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 2, Norris discloses sending a message, via the telecommunication address, confirming that the at least some of the interaction data has been sent to the application (§ 60 discloses sending feedback to the pen in the form of a message to indicate that a signature has been received and verified, where the signature is the interaction data).

As per claims 3-6, Norris discloses all of the elements of the claimed invention but fails to explicitly disclose the form is disposed on a product label including human-readable information relating to the form, and the coded data relates to at least an identity of the label and includes a label identifier that is a unique product item identifier which is an electronic product code).

Lieberman discloses conducting a prize drawing game of chance having a form disposed on a product label including human-readable information relating to the form, and the coded data relates to at least an identity of the label (col. 3, line 15-30 discloses entry forms imprinted on a laser scannable barcode that uniquely identifies the particular product to be promoted, where the barcode is a label identifier/product item identifier/electronic product code).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method of processing information from a sensing device as taught by Norris to include the form disposed on a product label including information relating to the form and coded data relating to the identity of the label in order to promote a particular product or item of merchandise.

Claim 16 recites equivalent limitations to claim 2 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 8, Norris discloses that the sensing device is a unique identifier of the sensing device (§ 34 discloses the pen having a unique identifier).

Norris, however, fails to explicitly disclose that the sensing device ID is stored in the sensing device.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information via a sensing device of Norris to include that the sensing device ID is stored in the sensing device since it is old and well known for identifying information to be stored or contained in or on the particular item that it is identifying.



As per claim 14, Norris discloses only a single temporary registration is allocated per sensing device or user (see ¶ 61).

As per claim 17, Norris discloses the interaction data identifies a position of the sensing device relative to the form (¶ 33 discloses pattern position information).

Norris, however, fails to explicitly disclose identifying the form.

Braun discloses remote form completion identifying the form (¶ 63 discloses determining the type of form).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include identifying the form as taught by Braun in order to facilitate the processing of that particular form type.

As per claim 20, Norris discloses all of the elements of the claimed invention but fails to explicitly disclose the product label including one or more of: information fields that show information about the competition; button fields that generate one or more actions; and entry fields for user input.

Lieberman discloses conducting a prize drawing game of chance having a product label that includes information fields that show information about the competition and entry fields for user input (col. 3, line 15-29 discloses entry forms imprinted on the label of the product having entry fields for a user to input self identifying information and information about the drawing itself).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify processing of information using a sensing

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device of Norris to include the product label containing entry fields and information about the competition as taught by Lieberman in order to facilitate the promotion of the drawing and the particular product or item of merchandise.

As per claim 21, Braun discloses an input button (see ¶ 36).

Norris discloses all of the elements of the claimed invention but fails to explicitly disclose each button field is coincident or adjacent machine-readable coded data, the computer being configured to perform the action based on coded data sensed when the sensing device was used to interact with the button field.

Lieberman discloses conducting a prize drawing game of chance having a button field coincident machine readable coded data, the computer being configured to perform the action based on coded data sensed when the sensing device was used to interact with the label (col. 7, line 45-66 discloses the scanning of the barcode identifies the product to which a particular entry form pertains and sorts that entry form according to product, where the sorting may be automated).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include a computer performing an action based on coded data sensed when the sensing device was used to interact with the label since such would facilitate the processing of the entry forms for the drawing.

As per claim 22, Norris discloses a display device associated with the user and displaying information on the display device (¶ 29 discloses a display for displaying information on the pen).

Braun discloses a button (see ¶ 36).

Norris, however, fails to explicitly disclose an action associated with interacting with at least one of the button fields using the sensing device.

Lieberman discloses conducting a prize drawing game of chance performing an action based on data sensed when the sensing device was used to interact with the label (col. 7, line 45-66 discloses the scanning of the barcode identifies the product to which a particular entry form pertains and sorts that entry form according to product, where the sorting may be automated).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include a computer performing an action based on coded data sensed when the sensing device was used to interact with the label since such would facilitate the processing of the entry forms for the drawing.

As per claim 23, Norris discloses communication with the display device occurs via the telecommunication address (¶ 35 and Fig. 1 disclose communication links for sending and receiving information back and forth from/to the pen, where there inherently is some telecommunications address in order for such communications to take place).

As per claim 26, Norris discloses a pen that produces interaction data (see ¶ 42 and 43).

Norris discloses all of the elements of the claimed invention but fails to explicitly disclose using a product label for enabling entry to a competition, the product label comprising:

machine-readable coded data indicative of at least an identity of the label, said machine-readable coded data being readable by a sensing device as the sensing device is moved across the product label; human-readable information pertaining to the competition, the human-readable information being at least partially coincident with the machine-readable coded data, the human-readable information including at least one field element that has a corresponding zone defined in relation to it in a page description stored in a remote computer system.

Lieberman discloses, as best understood, conducting a prize drawing game of chance using a product label for enabling entry to a competition, the product label comprising:

machine-readable coded data indicative of at least an identity of the label, said machine-readable coded data being readable by a sensing device as the sensing device is moved across the product label; human-readable information pertaining to the competition, the human-readable information being at least partially coincident with the machine-readable coded data, the human-readable information including at least one field element that has a corresponding zone defined in relation to it in a page description stored in a remote computer system. (col. 3, line 15-29 discloses a laser scannable barcode on a product label that uniquely identifies a particular product and a label

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having an entry form for a competition entry, where the laser that scans the barcode is the sensing device, where the entry form is human readable);

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include the human readable and machine readable data on the product label as taught by Lieberman since such would facilitate the entry into the prize drawing.

And receiving coupon/prize redemption information from the coupon administrator (col. 8, line 8-16 discloses notifying the entrant that they have won a prize).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include coupons on product labels and receiving coupon redemption information as taught by Lieberman in order to promote a particular product or merchandise item.

The Norris, Braun, Pradhan, Nishida, and Lieberman combination discloses all of the elements of the claimed invention but fails to explicitly disclose only receiving a predetermined combination of coupon offers that has been transmitted to the coupon administrator.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of the Norris, Braun, Pradhan, Nishida, and Lieberman combination to include only

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receiving a predetermined amount of coupon offers because it is old and well known for a lottery, prize drawing, or competition coordinator to only allow an entrant to submit a predetermined amount of competition entries since such would prevent users from flooding the competition with a large number of entries to increase their chances of winning.

As per claim 31, Norris discloses all of the elements of the claimed invention but fails to explicitly disclose that the form data is for a competition entry.

Lieberman discloses conducting a prize drawing game of chance where an entry form is scanned for entry into a competition (see col. 3, line 15-29).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the processing of information using a sensing device of Norris to include the competition entry as taught by Lieberman in order to facilitate the promotion of a particular product or item of merchandise.

**4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norris in view of Braun in view of Pradhan in view of Lieberman in view of Nishida, and further in view of Dougherty et al. (6,076,734, hereafter Daugherty).**

As per claim 7, the Norris, Braun, Pradhan, Lieberman and Nishida combination discloses all of the elements of the claimed invention but fails to explicitly disclose the coded data is substantially invisible to a human.

Daugherty discloses an encoding scheme having coded data that is invisible to a human (§ 33 discloses a barcode printed using invisible inks).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method of processing via a sensing device of Norris to include the invisible coded data as taught by Daugherty because it is a well known barcode scheme.

### ***Response to Arguments***

5. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Applicant's arguments with respect to claims 1 and 15 that the cited references fail to disclose "a unique alias registration for every competition entry performed using the sensing device" have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Philyaw (6,636,892) discloses a method for conducting a contest using a network. Howson (6,540,608) discloses a lottery. Roseman (6,012,984) discloses systems for providing large games. Higginson et al. (6,532,448) discloses a contest server. Libby et al. (5,722,890 discloses a lottery system).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday- Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jamisue Plucinski can be reached on (571)272-6811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. C./  
Examiner, Art Unit 3629

/Traci L Casler/  
Primary Examiner, Art Unit 3629